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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,444	10/12/2000	Mina Farr	17516-007520	7384
20350	7590	01/30/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 01/30/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	FARR ET AL.	
Examiner John P. Leubecker	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 November 2003.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5,7-9,11-13 and 43-70 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) 43-48,54-56 and 61-70 is/are allowed.
6) Claim(s) 1-5,8,12,13,49 and 57-59 is/are rejected.
7) Claim(s) 7,9,11,50-53 and 60 is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

Election/Restrictions

1. The Election of Species Requirement mailed August 27, 2003 (paper number 11) is hereby withdrawn. After review of said Requirement, the Examiner now in charge of this application has deemed such requirement improper. It is noted that in Applicant's response filed November 3, 2003, Applicant requested the cancellation of claims 54-61 as drawn to a non-elected species. Since this request was inadvertently ignored and the Election of Species Requirement is withdrawn, claims 54-61 will remain in the application. Therefore, claims 1-5, 7-9, 11-13 and 43-70¹ are being examined.

Applicant's representative, Craig Wong, was informed of the withdrawal of the Election of Species Requirement and inclusion of claims 54-61 in the examined claims in a phone conversation held on January 22, 2004.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or

¹ It is noted that a claim numbering error is present in Applicant's amendment filed June 2, 2003. Claim number "55" is not present in the listing of claims (see page 7). For the purposes of maintaining an accurate claim count, claims 56-71 on pages 7-11, including claim dependencies, have been renumbered as claims 55-70. This renumbering is only done in pencil and will be used by the Examiner when referring to these claims. Applicant is required to use this renumbering in any future correspondence as if it were the original numbering.

continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Specification

3. The disclosure is objected to because of the following informalities: First paragraph of specification that refers to a provisional application by the attorney docket number should be corrected.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8, 49, 54 and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 8, phrase "the objective lens forming a first intermediate image within the lens" (line 8) is indefinite. It appears that this should have been --the objective lens *system* forming a first intermediate image within the lens--.

As to claims 49, 54, and 57, note similar defect as described with respect to claim 8.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 8, 12, 13, 57-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Tateyama et al. (U.S. Pat. 5,852,511).

As to claim 8 and 59, Tateyama et al. disclose an endoscope including an ocular lens system (E, Fig.6), a relay lens system (R, Fig.6) and an objective lens system (O, Fig.6) comprising a lens (lens containing image P), wherein a space exists between the relay lens system (R) and ocular lens system (E) and no intermediate image is disposed within this space (note that the intermediate image is formed within the ocular lens system as shown by the double ended arrow between the lenses of lens system (E). As to claim 12 and 57, note Figure 10. As to claim 13 and 58, note refractive indices listed in column 8.

8. Claims 57 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonnell et al. (U.S. Pat. 5,833,596).

Referring to Figure 14, Bonnell et al. disclose an endoscope including an ocular lens system (212), a relay lens system (208,210) and a objective lens system (206) having a lens (228) with an intermediate image (229) formed therein, wherein an optical element (238) is disposed between each pair of adjacent relay units so that an intermediate image (240) is formed therein. As to claim 58, note col. 15, lines 61-62.

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9. Claims 1-5 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Ibe (U.S. Pat. 6,049,422).

Referring to Figure 3, Ibe discloses an endoscope including an objective lens system (1), an ocular lens system (3) and a relay lens system (2), wherein an intermediate image (r_{17}) is formed within an optical element in the objective lens system and wherein an objective-relay gap separates the objective lens system and the relay lens system and no intermediate image is formed therein. Note rejection in numbered paragraph 2 of the previous Office Action, paper number 8.

Response to Arguments

10. Applicant's arguments with respect to the claims filed June 2, 2003 have been considered but are moot in view of the new ground(s) of rejection. As noted in the Election/Restriction Requirement, paper number 11, the indicated allowability of certain claims has been withdrawn. Therefore, all claims have been reexamined. Accordingly, this Office Action has not been made final.

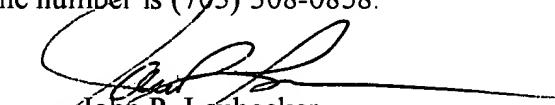
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


John P. Leubecker
Primary Examiner
Art Unit 3739

jpl